

POPT-0002

PATENT

prior to consideration of this response. Please contact Applicants' undersigned attorney at 215.564.8382 to discuss the outstanding rejections and pending claims.

REMARKS

Claims 21-89 are pending in this case. Claims 21 through 89 stand finally rejected under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent 6,317,726 (O'Shaughnessy II) in view of U.S. Patent 5,918,217 (Maggioncalda), U.S. Patent 5,784,696 (Melnikoff), and U.S. Patent 6,321,212 (Lange). Applicants respectfully request reconsideration of the present application in light of the below-recited remarks.

Initialed PTO FORM-1449

In a communication mailed October 20, 2000, Applicants submitted an Information Disclosure Statement and PTO FORM-1449. An Examiner-initialed copy of the FORM-1449 has not been received. Applicants' undersigned attorney respectfully requests that the Examiner provide an initialed copy of the FORM 1449 indicating the Examiner has considered the references in connection with this application.

POPT-0002

PATENT

Rejections Under 35 U.S.C. § 103(a)

Claims 21 through 89 stand rejected as allegedly being obvious over O'Shaughnessy II in view of Maggioncalda, Melnikoff, and Lange. Applicant respectfully disagrees.

The Claimed Invention

The present application discloses "a method of filtering and sorting online financial data." (Application, Field of the Invention). More specifically, the claimed invention relates to "an interactive method . . . for **timely processing data to meet the criteria of individual clients**. This criteria can be easily changed to allow these **clients the ability to request many variations of the data based on their individual needs**." (Application, Summary of the Invention).

Accordingly, claim 21, which is representative of the other independent claims, is directed to a "method of identifying financial instruments meeting user-defined investment criteria." The claimed method comprises the following steps:

"retrieving financial instrument data from at least one data source;

processing the financial instrument data to identify values for a plurality of searchable parameters for particular financial

POPT-0002

PATENT

instruments in said financial instrument data;

receiving user-defined search criteria for said searchable parameters;

comparing the user-defined search criteria with the values identified for the searchable parameters for the particular financial instruments; and

identifying at least one of the financial instruments having values for the searchable parameters matching the user-defined search criteria."

In order for a set of references to render obvious this and the other independent claims, the references must teach the combination of all of the claimed elements, including those emphasized. Applicants' undersigned attorney respectfully submits that the cited references do not.

The Cited References Do Not Teach the Claimed Invention

The Examiner cites U.S. Patent 6,317,726 (O'Shaughnessy II) as prior art. As the Examiner correctly points out, O'Shaughnessy II is a continuation-in-part of prior application 08/995,296 filed on December 20, 1997, which has since issued as U.S. Patent 5,978,778 (O'Shaughnessy I). Thus, the subject

POPT-0002

PATENT

matter that existed in the prior O'Shaughnessy application, i.e. O'Shaughnessy I, is prior art to the present application. However, the new matter that was added, i.e. the "in-part" portion of the O'Shaughnessy II, has a filing date of July 27, 1999. Importantly, the present application has an effective filing date of May 29, 1998 and claims priority back to provisional patent application 60/055,403 filed August 8, 1997. Accordingly, the new matter added to O'Shaughnessy II upon its filing (wherein the new matter includes at least items 1-12 and 1-13 of Fig. 1; items 2-10 through 2-15 of Fig. 2; and Figures 3 through 17 and associated text) is **not** prior art to the present application. Rather, the only matter of O'Shaughnessy II that is prior art to the present application, is that matter that existed in O'Shaughnessy I.

Furthermore, U.S. Patent 5,978,778 (O'Shaughnessy I), from which O'Shaughnessy II is a continuation-in-part, does not teach the elements of the claimed invention. O'Shaughnessy I teaches a method for selecting a portfolio of stocks. Specifically, O'Shaughnessy I teaches screening stocks against a predetermined, i.e. **not user-defined**, set of criteria to arrive at an alleged optimal portfolio of stocks. As illustrated in Figures 1 and 2 of O'Shaughnessy I, the stocks are screened sequentially against

POPT-0002

PATENT

the **predetermined set of criteria**, with the stocks not meeting any one criteria being removed from further evaluation. In contrast to O'Shaughnessy I, Applicants' methods require **"receiving user-defined search criteria** for said searchable parameters," and **"comparing the user-defined search criteria with the values identified for the searchable parameters** for the particular financial instruments." O'Shaughnessy I entirely fails to teach these claimed elements. Indeed, by teaching a predetermined set of filtering criteria, O'Shaughnessy I actually teaches away from accepting **user-defined criteria** and comparing these to values for searchable parameters.

Melnikoff is directed to methods for evaluating portfolios based on investment risk. According to Melnikoff, an asset, or a set of assets and their relative proportions, are selected from a library of assets to form a tentative investment portfolio. (Melnikoff, Col. 4, ll. 15-17). The average relative performance of the portfolio is computed. (Melnikoff, Col. 4, ln. 16.) The performance of the tentative portfolio is compared to criteria derived from investor preference data. If the criteria are satisfied, the tentative portfolio is designated as the investment portfolio. If not, a new tentative portfolio is selected and the processing sequence is repeated in an iterative

POPT-0002

PATENT

manner until the criteria derived from the investor preference data are satisfied. (Melnikoff, Col. 4, ll. 32-29.) Thus, Melnikoff teaches an automated iterative loop for testing potential portfolio asset allocations against a desired investment risk to arrive at a single portfolio. In contradistinction to the claimed invention, Melnikoff simply does not teach "processing the financial instrument data to **identify values for a plurality of searchable parameters** for particular financial instruments in said financial instrument data" and "**receiving user-defined search criteria for said searchable parameters.**" Accordingly, Melnikoff cannot possibly teach "**comparing the user-defined search criteria with the values identified for the searchable parameters** for the particular financial instruments."

Maggioncalda has a filing date of December 10, 1997. The present application is a continuation of application 09/086,739 filed May 29, 1998, which claims priority to provisional application 60/055,403 filed August 8, 1997. Thus, Maggioncalda is not prior art against the present application. Furthermore, even if Maggioncalda were prior art, which it is not, it neither teaches nor suggests "**receiving user-defined search criteria for said searchable parameters**" and "**comparing the user-defined**

POPT-0002

PATENT

search criteria with the values identified for the searchable parameters for the particular financial instruments."

The Examiner also cites to Lange as teaching various aspects of the claimed invention. Lange was filed November 24, 1999 and claims priority to a provisional application filed July 21, 1999. As noted above, the present application is a continuation of application 09/086,739 filed May 29, 1998, which claims priority to provisional application 60/055,403 filed August 8, 1997. Accordingly, Lange is not prior art to the present application.

In summary, neither O'Shaughnessy nor Melnikoff teach or even suggest the claimed elements. Furthermore, Maggioncalda and Lange are not prior art to the present application. Accordingly, Applicants' undersigned attorney respectfully submits that all claims patentably define over the prior art references and requests withdrawal of the prior art rejections.

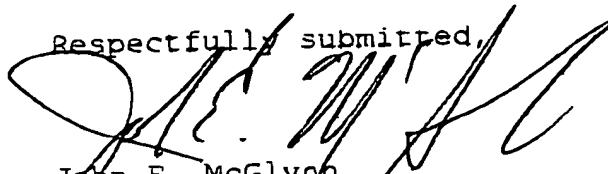
CONCLUSION

For all the foregoing reasons, Applicants respectfully submit that claims 21-89 patentably define over the prior art of record. Reconsideration of the present Office Action and a Notice of Allowance are respectfully requested.

POPT-0002

PATENT

Respectfully submitted,



John E. McGlynn

Registration No. 42,863

Date:

1/24/03

WOODCOCK WASHBURN LLP
One Liberty Place - 46th Floor
Philadelphia, PA 19103
(215) 568-3100